



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,572	01/18/2001	Eva Ackerman	041443-00752	6865
22904	7590	10/26/2005	EXAMINER	
LOCKE LIDDELL & SAPP LLP 600 TRAVIS 3400 CHASE TOWER HOUSTON, TX 77002-3095			PATEL, DHIRUBHAI R	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/764,572

Applicant(s)

ACKERMAN ET AL.

Examiner

DHIRU R. PATEL

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-27, 37, 38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-27, 37, 38 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 2831

### **DETAILED ACTION**

1. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The applicant has failed to provide the following with respect to Declaration in Exhibits A through E for claims 23 and 27 :

For claim 23: a method of assisting a compromised barrier comprising : placing the fire retardant gasket between a faceplate and an electrical box, coupling the faceplate to the box, and at least partially reestablishing a fire rating of the barrier.

For claim 37, a method of assisting a compromised barrier comprising: installing into a fire rated barrier an electrical box, introducing into the electrical box a fire retardant gasket, and covering the electrical box with a faceplate . The Exhibits provide the following:

Exhibit A discussed a gasket for cover plates and two successful tests of gaskets.

Exhibit B discussed electrical box inserts.

Exhibit C discussed a metal and standard metal .

Exhibit D discussed a plate, a box, hole and cold faces.

Exhibit E testing of 1.5 mm blazeseal electrical plate covers .

Art Unit: 2831

The Exhibits A through E failed to provide the claimed subject matter as mentioned above for the claims 23 and 37.

**Exhibits A through E are insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference.**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23 line 8, " at least partially reestablishing a fire rating of the barrier" is confusing and unclear in light of the specification because the specification does not disclose definition of at least partially reestablishing a fire rating of the barrier?.

Art Unit: 2831

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 23-27, 37-38, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dykhoff et al (6,521,834).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 23, as best understood, a method of assisting a compromised barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) comprising:

Art Unit: 2831

- a) providing a gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) comprising fire retardant material of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 23-30, column 11 lines 24-67, column 12 lines 1- 24) containing **an intumescent graphite** ( see abstract lines 11-14, column 9 lines 3- 30, please note that the fire stopping mat include an intumescent compound);
- b) placing the fire retardant gasket 8 between a faceplate 6 and an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, see column 4 lines 30-53, column 14 lines 38-55) adapted to be introduced into the barrier 4 ( see fig 1, column 3 lines 20-50, column 4 lines 30-60, column 14 lines 45-52);
- c) coupling the faceplate 6 to the box 10 ( see fig 1 , column 3 lines 40-50, column 4 lines 30-54, column 15 lines 1-5) ;
- and d) at least partially reestablishing a fire rating of the barrier (see column 1 lines 15-35, column 2 lines 20-26, column 3 lines 5-50, column 4 lines 54-62, column 14 lines 45-52).

Regarding claim 24 , as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising coupling the gasket 8 in situ between the faceplate 6 and the box 10 (see fig1, column 3 lines 30-50, column 4 lines 30-62, column 16 lines 10-16 ).

Regarding claim 25 , as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including providing the

Art Unit: 2831

gasket 8 comprises forming the gasket 8 as a separate element (see fig 1, column 3 lines 40-50, column 4 lines 35-40, column 16 lines 10-16) prior to placing the gasket 8 between the faceplate 6 and the box 10 (see fig1, column 4 lines 30-50 and column 16 lines 10-16).

Regarding claim 26 , as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising forming the gasket 8 on one surface of the faceplate 6 prior to coupling the faceplate 6 to the box 10 (see column 3 lines 40-50, column 4 lines 54-62, column 16 lines 10-16).

Regarding claim 27, as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the gasket is being formed by establishing a coating of the fire retardant material onto the faceplate 6 (see column 2 lines 29-35, column 3 lines 40-45, column 15 lines 1-14).

**Assembly of the device of Dykhoff et al comprises a method steps of:**

Regarding claim 37, a method of assisting a compromised barrier ( a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) comprising:

a) installing into a fire rated barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-12, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, column 4 lines 40-45, column 14 lines 38-55) , the

Art Unit: 2831

electrical box 10 compromising the fire resistance of the fire rated barrier (see column 1 lines 5-40, column 2 lines 1-28, column 3 lines 40-50, column 4 lines 30-45),

b) introducing into the electrical box 10 a fire retardant gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 20-30, column 11 lines 24-67, column 12 lines 1- 24) containing **an intumescent graphite** ( see abstract lines 11-14, column 9 lines 3- 30, please note that the fire stopping mat include an intumescent compound) ; and covering the electrical box 10 with a faceplate 6 ( see fig 1, column 2 lines 1- 10, column 3 lines 40-45, column 4 lines 30-54, column 14 lines 40-55).

Regarding claim 38, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being adhered to the faceplate 6 prior to covering the electrical box 10 with the faceplate 6 (see column 2 lines 1-10, column 3 lines 40-50, column 14 lines 40-50, column 16 lines 10-18).

Regarding claim 40, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being introduced to the electrical box 10 without removing the electrical box 10 from the fire resistant barrier (see fig 1, column 2 lines 10-40, column 3 lines 30-50).



Art Unit: 2831

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 23-26 and 37-38,40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Close Jr (4,163,137) in view of Landin (6,153,674).

Assembly of the device of Close comprises a method steps of:

Art Unit: 2831

Regarding claim 23, as best understood, a method of assisting a compromised barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10 ) comprising:

- a) providing a gasket 70, 70', 90 (see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, column 4 lines 1-45) comprising fire retardant material of a fire resistant insulative material ( **please note that the Close disclosed the gaskets 70' may be formed from a single sheet 98, and sheet 98 having fire retardant properties (see column 5 lines 15-45 )** as well as the gasket may be vulcanized (see column 2 lines 1-5):
- b) placing the fire retardant gasket 70, 70' between a faceplate 50, 50' and an electrical box 28 (see figs 3 and 7, column 2 lines 1-5, and the entire column 3) adapted to be introduced into the barrier ( see figs 3 and 7 and the entire column 3);
- c) coupling the faceplate 50, 50' to the box 28 ( see figs 3 and 7 and the entire column 3 and the entire column 5) ; and d) at least partially reestablishing a fire rating of the barrier (see the entire column 3 and the entire column 6), but fails to disclose the fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite.

Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see

Art Unit: 2831

column 3 lines 29-67, column 4 lines 1-38 ) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62).

It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidenced by **Landian**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses, and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

Art Unit: 2831

suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 24 , as best understood, the modified assembly of Close disclose all of the claimed features as shown above, including coupling the gasket 70, 70' (see figs 3 and 7 of Close) in situ between the faceplate 50, 50' and the box 28 (see figs 3 and 7, column 2 lines 1-5 of Close).

Regarding claim 25 , as best understood, the modified assembly of Close disclose all of the claimed features as shown above, including the gasket 70, 70' comprises forming the gasket 70, 70' as a separate element (see fig of Close) prior to placing the gasket 70, 70' between the faceplate 50,50' and the box 28 (see figs 3-4 and 7, column 2 lines 1-5 of Close).

Regarding claim 26 , as best understood, the modified assembly of Close disclose all of the claimed features as shown above, including forming the gasket 70, 70' on one surface of the faceplate 50,50' prior to coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7, column 2 lines 1-5 of Close).

**Close disclose:**

Assembly of the device of Close comprises the method steps of:

Regarding claim 37, a method for assisting a compromised barrier

(a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) comprising:

Art Unit: 2831

a) installing into a fire rated barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10 ) an electrical box 28 ( see figs 3,7 and the entire column 3) , the electrical box 28 compromising the fire resistance of the fire rated barrier (see the entire specification),

b) introducing into the electrical box 28 a fire retardant gasket 70, 70', 90 ( (see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, and the entire column 5); and covering the electrical box 28 with a faceplate 50, 50' ( see figs 3,7 and the entire column 3 and the column 6), but fails to disclose the fire retardant gasket of a fire resistant insulative material containing mineral wool or intumescent graphite.

Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses ( see column 10 lines 50-62).

Art Unit: 2831

It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidenced by Landin. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses, and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 38, the modified assembly of Close discloses all of the claimed features as shown above, including the fire retardant gasket being adhered to the faceplate prior to covering the electrical box 28 with the faceplate (see fig 3 and the entire specification of Close).

Regarding claim 40, the modified assembly of Close discloses all of the claimed features as shown above, including the fire retardant gasket being introduced to

Art Unit: 2831

the electrical box 28 without removing the electrical box from the fire resistant barrier (see fig 3, and the entire specification of close).

### **Response to Arguments**

5. Applicants' arguments with respect to claims 23-27, 37-38, 40 have been considered but they are not persuasive. **The applicant argues the following:**

**A) Examiner's Rejection of claims 23-27, 37-38 and 40 Under 35 U.S.C.**

**102(e) over Dykoff.** The examiner continues to refuse to review the supporting exhibits of the Declaration in their entirety, for instance, the examiner indicates that "Exhibit A" fails to provide information " about a gasket comprising fire retardant material of a fire resistant insulated material containing mineral wool or intumescent graphite". The examiner incorrectly concludes that 37 CFR 1.131 requires that a single exhibit contain a elements of a claim ..... The totality of the supporting exhibits attached to the declaration establishes invention of the subject matter of the rejected claims prior to August 25, 2000 (page 1 of remarks), and the examiner in the original paragraph pages 15 and 16 of the office action concludes erroneously that the declaration is insufficient to overcome the rejection of the claims over Dykhoff. The examiner is respectfully requested to reconsider the supporting exhibits in their totality and withdraw the rejection of the claims over Dykhoff (page 2 of remarks).

Art Unit: 2831

With respect to argument **A**, the examiner respectfully traverse because the Exhibits A through E failed to provide the claimed subject matter as mentioned above for claims 23 and 37 (see item 1 of this office action).

**Exhibits A through E are insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference.**

Further, the DECLARATION under 37 CFR 1.131 filed dated 3/30/04 is insufficient to overcome the rejection of claims 23-27, 37-38, 40 based upon anticipated by Dykhoff et al reference as set forth in the current Office action as mentioned above and in light of the above comments, **the examiner respectfully submits that the rejection of claims 23-27 and 37-38 is proper and just.**

**B)** Examiner's Rejection of the Claims Under the Second paragraph of 35 U. S. C. 112 (page 2 of remarks) .... thus, the claimed terminology of " at least partially reestablishing a fire rating of the barrier" is not indefinite to those of skill in the art (page 3 of remarks).

With respect to argument **B**, the examiner respectfully traverse because the specification does not disclose a definition of at least partially reestablishing a fire rating of the barrier.

Specifically, **35 U. S. C. 112 first paragraph states :**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skill in the art to which it pertains, or with which it



Art Unit: 2831

is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Also, **the specification failed to disclose the definition of at least partially reestablishing a fire rating of the barrier** in order for those skilled in the art to understand the scope of the **claim when the claim is read in light of the rest of the specification**, further applicants' argues that barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours and **the original specification does not disclose** barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours, **therefore, the claimed terminology of " at least partially reestablishing a fire rating of the barrier is indefinite to those of skill in the art when the claim is read in light of the rest of the specification.**

C) The examiner argues that the claimed terminology " is confusing and unclear in light of the specification .....Applicant has already provided to the examiner **articles which reference test method of measuring fire resistive properties of assemblies used in buildings, one of skill in the art ..... what is meant by reestablishing a fire rating of a barrier. The term " at least partially reestablishing " is neither confusing nor unclear (page 3 of remarks).**

With respect to argument **C**, since applicant mentioned in his argument that Applicant has already provided to the examiner articles which reference test method of measuring fire resistive properties of assemblies used in buildings and

Art Unit: 2831

does not mention about what standard being used **for the test method**. The examiner assumed the test method is ASTM standard (E 814 and E 119 provided by the applicant) and the examiner respectfully traverse because ASTM (E 814) clearly disclosed that the test method is applicable to through-penetration fire stops of various material and construction and definition of a fire stop- a through penetration fire stop is a specific construction consisting of the materials that fill the opening around penetrating items such as cables, cable trays, conduits, ducts and pipes and their means of support through the wall or floor opening to prevent spread of fire (see 3.1 and 3.11 of E-814, which is provided by the applicant) and the test did not mention for a gasket and an electrical box , further the test also disclosed that the test method is used to determine the performance of a fire stop with respect to exposure **to a standard temperature - time fire test and hose steam test and the ratings are established for each fire stop based upon the temperature rise as well as flame occurrence on the unexposed side of the fire stop and the control of fire tests for the fire environment within the furnace shall be in accordance with the standard temperature - time curves shown in Fig 1 of E 119 .**

Therefore , as claimed “ at least partially reestablishing a fire rating of the barrier is unclear in light of the specification as well as the test method provided by the applicant.

Art Unit: 2831

**It is noted that articles which reference test methods (ASTM) of measuring fire resistive properties for the fire environment within the furnace with a standard temperature, and the Exhibit A provide the information for the first test was F0419029 and sample of the gaskets used with the plastic cover plates in Test F0419029 and the second test was F0420037. Applicant to clarify that what standard being used for the first test F0419029 and the second test F0420037.**

**D)** the gasket of Close is plastic and plastics are not fire resistant insulative materials .

With respect to argument **D**, the examiner respectfully traverse because Close disclosed that all of the gaskets being formed of sponge rubber or other sponge, easily compressible material (see column 4 lines 38-41 of close) as well as the gasket may be vulcanized, see column 2 lines 1-5 of close.

**E)** it is unclear why one of skill in the art would substitute such intumescent material for the gasket of close.

With respect to argument **E**, the examiner respectfully traverse because Close disclosed that all of the gaskets being formed of sponge rubber or other spongy, easily compressible material as well as the gasket may be vulcanized , see column 2 lines 1-5 of close and the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

Art Unit: 2831

suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

**F)** The compromised barrier of Applicants' claims has a certain fire rating from one area on one side of the barrier to another area on another side of the barrier.

With respect to argument **F**, the examiner respectfully traverse because claims do not claim a certain fire rating from one area on one side of the barrier to another area on another side of the barrier.

**G)** The "suggestion" of combining the references must be evident from the references themselves. There is no suggestion in the references that they be combined.

With respect to argument **G**, the examiner respectfully traverse because Landin reference teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of

Art Unit: 2831

time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses ( see column 10 lines 50-62).

Therefore, suggestion in the Landin reference that they be combined.

H)The gasket of close is employed to prevent air infiltration and , such , prevent cool air from flowing into the room (col 3 lines 55-59).

With respect to argument H, the examiner respectfully traverse because close did disclose that the improvement comprising: a gasket for sealing around an opening (a wall having an opening, see column 6 lines 7-8 of close) and device (an electrical device mounted in box, see column 6 lines 7–11 of close) to prevent passage of air (see abstract lines 1-2 and column 6 lines 19-22 of close).

### ***Conclusion***

**6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 2831

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel

Primary Examiner

Group Art Unit 2831

October 22, 2005

  
DHIRU R. PATEL  
PRIMARY EXAMINER  
10/22/05